

DETAILED ACTION

This is in reference to communication received 27 January 2011. Claims 21 – 46 are pending for examination.

Declaration Under 37 C.F.R. 1.131

The Declaration Under 37 CFR 1.131 filed 04 June 2009 to overcome the rejection of claims 21 – 46 based on John Cook newspaper article "Well-Funded Xpertsite.com Making Hay With Its Popular Answer Service" in view of archived web pages of Keen.com. On page 2 of the declaration, Applicant has stated that the invention was conceived on or about 03 February 2000, and provided exhibits 1 – 14. Applicant also stated that applicant started downloading research on the invention on 03 February 2000. Applicant states that between 23 February 2000 and 20 April 2000, applicant reviewed the downloaded information to determine how to best implement the conceived invention. Also, in declaration filed 04 June 2009, applicant recited that between 20 April 2000 and 09 August 2000, researched best manner of implementing and describing the invention, and on 09 August 2000, applicant wrote the "Patent Method" which is presented as Exhibits 10 - 11. The statement and exhibits provided by the applicant does not demonstrate that the concept of all of the limitations in the claimed invention.

- contact information of the receiver is hidden from the communication device

- how the relationship between text from the user to the recipient, and response from the recipient to the user is performed
- identification information of the user is tracked from the text communication from the receiver.
- Transferring of fee to the receiver, or charity on behalf of the receiver
- Contact of the receiver is an account or and address
- Receiving confirmation of delivery of the text by a user

were conceived prior to 03 February 2000.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Also, cited reference John Cook newspaper article "Well-Funded Xpertsite.com Making Hay With Its Popular Answer Service" article states that Xpertsite.com was co-founded by Ramesh Parameswaran in August. A Business Week article "Outta Here at Microsoft" dated 29 November 1999 also states that in August 1999, Ramesh Parameswaran quit Microsoft to start XpertSite.com, and Xpertsite.com was launched on 11 November 1999.

Response to Arguments

In response to applicant's argument that applicant's disclosure filed 23 December 2009 establishes the Applicant conceived the invention prior to 29 February 2009 and reduced to practice on 20 April 2000.

It is not clear whether applicant is claiming conceive of invention date of 03 February 2000 or 29 February 2000. Also, as explained earlier, documents provided by the applicant does support the claimed invention as a whole.

In response to applicant's argument that applicant's disclosure teaches the claimed invention (see page 9).

However, said reference does not teach how on of ordinary skill in the art would enable to send a message to a receiver whose contact information is not known to the user and be able to return the response back from the receiver to the user whose earlier message said receiver is responding to. One of ordinary skill in the art will have to do undue experimentation to get the results as intended by the applicant as their claimed invention.

In response to applicant's argument that Keen.com is not applicable art and therefore, it should not be cited as a prior art.

However, Keen.com was in business prior to applicant's claimed earlier prior date of 03 February 2000, and therefore, Keen.com is an applicable prior art.

In response to applicant's argument that cited prior art MyEZmail in view of Shaw and Clark, or, Rochkind in view of Clark does not teach claimed invention because user must pay a fee before text must be transmitted, and also, receiver getting portion of the Fee.

However, charging a Fee for providing services or providing services for a Free is Business Decision. A Business may initially decide to provide services for free to increase customer base and later adopt to charge Fee for services. As an example in the email industry, MCI mail and AOL both charged fee to the users, whereas, Hotmail.com decided to give free email service to their users. Also, collected Fee given to the receiver is also old and known that, to generate operational revenue, Businesses share portion of collected revenue with experts.

Applicant's other arguments and concerns are responded to in response to pending claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21 – 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's disclosure does not disclose:

contact information of the receiver is hidden from the communication device

how the identification of the user is tracked for a return text communication from the receiver. For example, how plurality users with common name like John Smith is tracked so that the return text communication from the receiver is provided to the proper user.

how is the communication via physical mail exchanged between the user and the receiver.

how is the communication exchanged between the user and the receiver when the contact information of the receiver is an account

how does the sender identify the recipient to send the message to.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21 – 46 are rejected under 35 U.S.C. 112, second paragraph, as being vague to determine the scope of the subject matter which applicant regards as the invention. As currently claimed, it is not clear:

how a user makes a selection of a receiver to receive text when the contact information of the receiver is not known to the user, is the user provided with a list of receivers?

whether the return text communication from the user is even provided to the proper user who paid the fee”

during the transmission of the text from the transmission text from the communication device to the receiver through the intermediary facility, how it the text transmitted to the receiver, when the contact information of the user is not know to the communication device.

how is the communication via physical mail exchanged between the user and the receiver.

how is the communication is exchanged between the user and the receiver when the contact information of the receiver is an account

how does the sender select the recipient to send the message to. Is the recipient presented with the menu of recipients?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 – 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Business Wire article “14 Year Old Entrepreneur Launches State-Of-The-Art Free Email Forwarding Service to Internet Users” hereinafter known as MyEZmail in view of Shaw et al. US Patent 6,249,807 and Don Clark article “Keen.com Web Service to Allow Private Phone Chats”.

Regarding Claims 21, 31 and 39, as best understood by examiner, MyEZmail teaches system and method for forwarding email sent to a user's account (i.e. recipient account) to their current email address without sender's knowledge.

MyEZmail teaches capability and concept for:

Connecting communication device with an intermediary facility [MyEZmail.com]

MyEZmail does not explicitly recite sender selecting a receiver. However, MyEZmail teaches capability and concept for sender to identify a recipient to send the message to. Shaw teaches system and method for email management. Shaw teaches capability and concept for providing to sender selection capability for the sender to select recipient [Shaw, Fig. 8 and disclosure associated with the Figure]. Also, **it is old**

and known that corporate mail systems can hide the email address of the recipient by providing Global Lists, allowing user to create contact list, etc.

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify MyEZmail by adopting of shaw and allow sender to select from a list recipient to make the system and method user friendly, minimizing sender entering email address of the user every time they want to send a message to the recipient; apply a known technique to a known device (method, or product) ready for improvement to yield predictable results; known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art.

MyEZmail in view of Shaw teaches capability and concept for:

Connecting communication device with an intermediary facility [MyEZmail.com]

Selecting a receiver to receive text from a user [Shaw].

Even though MyEZmail in view of Shaw does not explicitly recite charging fee to user, however, MyEZmail teaches capability and concept for generating revenue from sponsors. Clark teaches capability and concept for recipient charging fee to senders.

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify MyEZmail in view of Shaw by adopting teachings of Clark to generate a new income source for recipient celebrities; apply a known technique to a known device (method, or product) ready for improvement to yield predictable results; known work in one field of endeavor may prompt variations of it for use in either the

same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art

MyEZmail in view of Shaw and Clark teaches capability and concept for:

transferring a fee from a user [Clark];

transmitting the text from the communication device to the receiver through the intermediary facility [MyEZmail]

wherein contact information of the receiver is hidden from the communication device [EzMail], and identification information of the user can be tracked for a return text communication from the receiver [MyEZmail], and wherein as a result of at least a portion of the fee paid by the user, the receiver can receive a benefit by receiving the text.

Regarding Claims 22, MyEZmail in view of Shaw and Clark teaches capability and concept wherein the intermediary facility can be a server.

Regarding Claims 23, 33 and 41, MyEZmail in view of Shaw and Clark teaches capability and concept wherein the text can be transmitted as an electronic mail (e-mail) message.

Regarding Claims 24, 34 and 42, MyEZmail in view of Shaw and Clark teaches capability and concept wherein the receiver can be a publicly known person.

Regarding Claims 25, 35 and 43, MyEZmail in view of Shaw and Clark teaches capability and concept wherein the contact information can be an account.

Regarding Claims 26, 36 and 44, MyEZmail in view of Shaw and Clark teaches capability and concept wherein the benefit can be one of personal benefit and a benefit given to a Charity.

Regarding Claims 27 and 37, MyEZmail in view of Shaw and Clark teaches capability and concept wherein the text can be transmitted on a network.

Regarding Claims 28, 38 and 45, MyEZmail in view of Shaw and Clark teaches capability and concept wherein the communication device receives a confirmation of delivery of the text, and the confirmation of delivery can be received as an e-mail **(Receiving Acknowledge Message from the recipient is old and known email technology)**.

Regarding Claims 29 and 46, MyEZmail in view of Shaw and Clark teaches capability and concept wherein the confirmation of delivery can be received as an e-mail.

Regarding Claims 30, 32 and 40, MyEZmail in view of Shaw and Clark teaches capability and concept wherein the fee can be paid for by a user of the communication device, and the fee can be paid to an account of the intermediary facility.

Claims 21 – 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rochkind US Patent 6,161,129 in view of Don Clark article “Keen.com Web Service to Allow Private Phone Chats”.

Regarding Claims 21, 31 and 39, as best understood by examiner, Rochkind teaches system and method for connecting a communication device with an intermediary facility [Rochkind, Fig.2 and disclosure associated with the Figure]. Rochkind does not explicitly recite hiding contact information of the receiver (target recipient). However, Clark teaches that to enforce privacy, Keen.com does not give contact information of the sender and receiver.

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Rochkind by adopting teachings of Clark and hide the contact information of the receiver also to enforce the privacy of the users; apply a known technique to a known device (method, or product) ready for improvement to yield predictable results; known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art

Rochkind in view of Clark concept and capability for:

Connecting communication device with an intermediary facility [Rochkind, Clark]

Selecting a receiver to receive text from a user [Rochkind, Clark]

transferring a fee from a user [Clark];

transmitting the text from the communication device to the receiver through the intermediary facility [Rochkind]

wherein contact information of the receiver is hidden from the communication device [Clark], and identification information of the user can be tracked for a return text communication from the receiver [Rochkind, Clark] , and wherein as a result of at least a portion of the fee paid by the user, the receiver can receive a benefit by receiving the text.

Regarding Claims 22, Rochkind in view of Clark teaches concept wherein the intermediary facility can be a server.

Regarding Claims 23, 33 and 41, Rochkind in view of Clark teaches concept wherein the text can be transmitted as an electronic mail (e-mail) message.

Regarding Claims 24, 34 and 42, Rochkind in view of Clark teaches concept wherein the receiver can be a publicly known person.

Regarding Claims 25, 35 and 43, Rochkind in view of Clark teaches concept wherein the contact information can be an account.

Regarding Claims 26, 36 and 44, Rochkind in view of Clark teaches concept wherein the benefit can be one of personal benefit and a benefit given to a Charity.

Regarding Claims 27 and 37, Rochkind in view of Clark teaches concept wherein the text can be transmitted on a network.

Regarding Claims 28, 38 and 45, Rochkind in view of Clark teaches concept wherein the communication device receives a confirmation of delivery of the text, and the confirmation of delivery can be received as an e-mail.

Regarding Claims 29 and 46, Rochkind in view of Clark teaches concept wherein the confirmation of delivery can be received as an e-mail.

Regarding Claims 30, 32 and 40, Rochkind in view of Clark teaches concept wherein the fee can be paid for by a user of the communication device, and the fee can be paid to an account of the intermediary facility.

Claims 21 – 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over John Cook newspaper article “Well-Funded Xpertsite.com Making Hay With Its Popular Answer Service” hereinafter known as Cook in view of previously cited archived web pages of Keen.com hereinafter known as Keen.

Regarding Claims 21, 31 and 39, as best understood by examiner, Cook teaches system and method for connecting a communication device with an intermediary facility (Xpertsite.com). Cook does not explicitly teach selecting a receiver to receive text. However, Cook teaches Keen.com as one on the competitors of Xpertsite.com. Keen teaches idea of selecting a receiver to receive text;

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cook as taught by Keen to allow the user to select a consultant of their choice, apply a known technique to a known device (method, or product) ready for improvement to yield predictable results.

Rochkind in view of Clark teaches concept for:

transferring a fee from a user [Keen, page 12];

transmitting the text from the communication device to the receiver through the intermediary facility (Keen teaches the concept wherein the phone number, email information of the users are hidden) [Keen, page 10, 14]

wherein text is transmitted from the communication device by a user to a receiver through the intermediary facility for a fee paid by the user [Keen, page 10, 11], and the contact information of the receiver is hidden from the communication device [Keen,

page 10], and identification information of the user can be tracked for a return text communication from the receiver [Keen, page 11] , and wherein as a result of at least a portion of the fee paid by the user, the receiver can receive a benefit by receiving the text.

Regarding Claims 22, Rochkind in view of Clark teaches concept wherein the intermediary facility is a server.

Regarding Claims 23, 33 and 41, Rochkind in view of Clark teaches concept wherein the text is transmitted as an electronic mail (e-mail) message [Keen, page 14].

Regarding Claims 24, 34 and 42, Rochkind in view of Clark teaches concept wherein the receiver can be a publicly known person.

Regarding Claims 25, 35 and 43, Rochkind in view of Clark teaches concept wherein the contact information can be an account.

Regarding Claims 26, 36 and 44, Rochkind in view of Clark teaches concept wherein the benefit can be one of personal benefit and a benefit given to a Charity.

Regarding Claims 27 and 37, Rochkind in view of Clark teaches concept wherein the text is transmitted on a network.

Regarding Claims 28, 38 and 45, Rochkind in view of Clark teaches concept wherein the communication device receives a confirmation of delivery of the text, and the confirmation of delivery can be received as an e-mail.

Regarding Claims 29 and 46, Rochkind in view of Clark teaches concept wherein the confirmation of delivery can be received as an e-mail.

Regarding Claims 30, 32 and 40, Rochkind in view of Clark teaches concept wherein the fee is paid for by a user of the communication device, and the fee is paid to an account of the intermediary facility.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Keen.com Connects Pro Football Stars Directly with Fans via Telephone During Super Bowl Week
2. New Site Takes a Guess at the Price of Wisdom
3. Keen.com plans Web Service Allowing Customers to Hole Private Phone Chats
4. Live from North Pole; Santa Talks to Kids & Parents, Answering All of Their Holiday Questions Using Keen.com
5. Keen.com Launches First Live Answer Community, Connects People with Information to Share Over Their Standard Telephone
6. Web Entrepreneurs Attempt to Charge A Price for Online Advice
7. Xpertsite.com Launches Expert Advice Site

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 10, 2011

/Naresh Vig/
Primary Examiner, Art Unit 3688